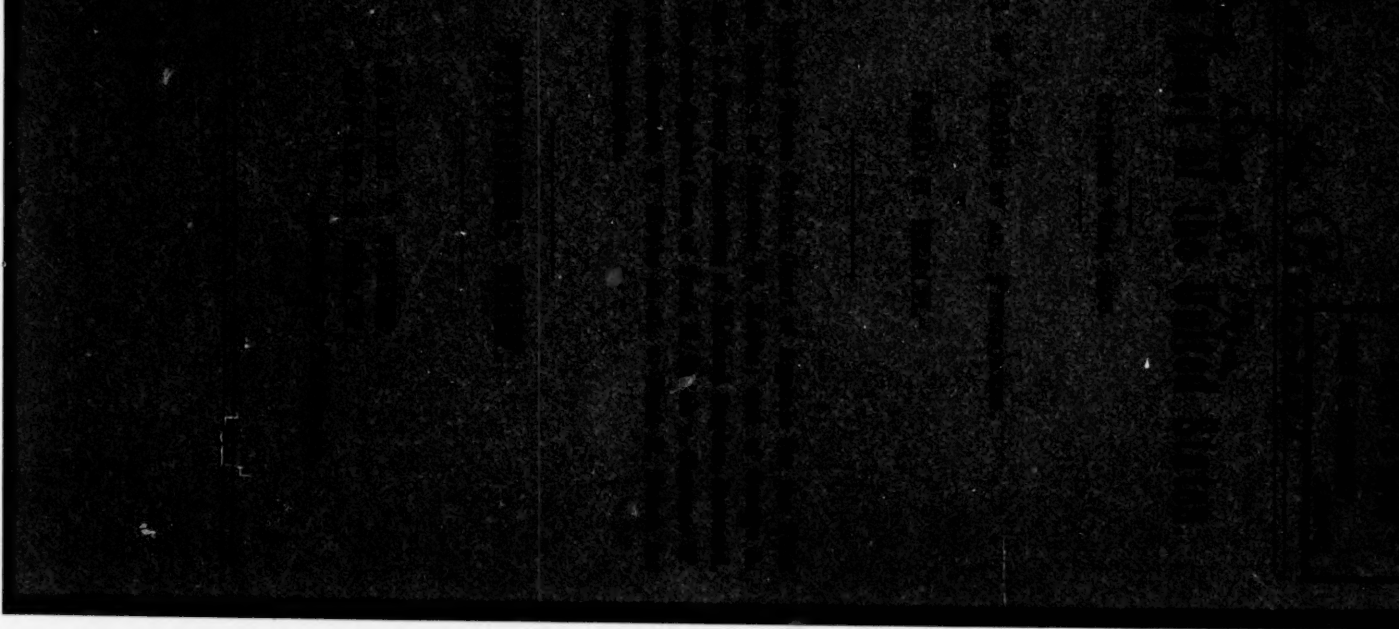

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1900.

No. 139.

C. W. HOBBS ET AL., PETITIONERS,

v.

FRED H. BEACH.

Certiorari to the United States Circuit Court of Appeals for the First Circuit, on the Petition of Clarence W. Hobbs; and of George A. Craig and Isaac L. Prouty, Executors of Richard Sugden, deceased, to Bring up the Cross-Appeal Case of Fred H. Beach v. Clarence W. Hobbs et al. and Clarence W. Hobbs et al. v. Fred H. Beach for Review and Determination.

STATEMENT OF CASE.

This cause was commenced by bill in equity in the Circuit Court of the United States for the District of Massachusetts for alleged infringement of claims 1, 2, 3 and 6 of the complainant's (F. H. Beach) United States Letters Patent, reissue No. 11,167, issued to F. H. Beach, May 26, 1891, for Machine for Attaching Stays to the Corners of Boxes.

After hearing on pleadings and proofs at the Circuit, his Honor Judge PUTNAM held that the defendants (C. W. Hobbs *et al.*) had not infringed the 1st, 2d and 3d claims and had infringed the 6th claim in suit. (*Beach* v. *Hobbs*, 82 Fed. Rep. 928.)

Complainant's petition for rehearing was denied (82 Fed. Rep. 928). Thereafter cross-appeals from the decree following Judge PUTNAM'S decision were taken by the respective parties, and, after hearing, the United States Court of Appeals for the First Circuit reversed

the decision at Circuit with respect to the first three claims of the patent and affirmed it as to the sixth claim, and remanded the cause to the Circuit Court with directions to proceed in conformity with the opinion, awarding costs in the Appellate Court to Beach. (*Beach* v. *Hobbs et al.*; *Hobbs et al.* v. *Beach*, 92 Fed. Rep. 151; C.C.A.)

Thereafter Hobbs *et al.* filed their petition in the Supreme Court of the United States for a writ of certiorari to the Court of Appeals for the First Circuit. The writ was granted, and the case now comes on for review and determination.

Beach's original patent No. 447,225, dated February 24, 1891, is found at Record pp. 445-452 and three sheets of drawings immediately preceding.

Beach filed his original application June 10, 1885.

Beach's reissue patent No. 11,167, dated May 26, 1891, is found at Record pp. 438-444.

Beach filed his reissue application April 9, 1891.

Defendants' Horton patent No. 442,582, dated December 9, 1890, is found at Record pp. 305-310 and five sheets of drawings immediately preceding.

Horton filed his patent application March 28, 1890; that is, 10 months and 26 days before Beach's original patent issued.

Horton's patent issued 2 months and 15 days before Beach's original patent issued.

The reissue in suit is substantially (*verbatim et literatim*) the same as the original patent. The sole defect upon which the reissue application was based was in Fig. 2 of the original patent drawing. In this figure there will be seen two parallel lines crossing the face of the box-rest B. This was a draughtsman's error in inking in the drawings. In Fig. 2 of the reissue these two parallel lines across the face of box-rest B are correctly omitted. The reissue contains immaterial verbal changes, but, except for the correction of figure 2, may be considered as identical with the original patent.

SPECIFICATION OF ERRORS.

Petitioners contend that the Court of Appeals for the First Circuit erred,—

First. In not holding that Beach's reissue patent in suit is invalid because issued in violation of the reissue statute — Sec. 4916, Rev. Sts.; the original patent, *qua* patent, not being either inoperative or invalid.

Second. In not holding that said reissue expired April 5th, 1892, in consequence of the expiration on that date of the Reed-Jaegar British patent of April 5th, 1888, for the same invention.

Third. In not holding that claims 1, 2 and 3 in suit are each limited (if valid at all) to specific details of construction and arrangement, by reason of Beach's acquiescence in repeated rejections by the Commissioner of Patents of such claims broadly considered.

Fourth. In not holding that claims 1, 2 and 3 are each necessarily limited, if they are good at all, to the precise details of construction set forth in the patent, in view of the prior art.

Fifth. In not holding that, in view of the prior art, claims 1, 2, 3 and 6 are each void for want of patentable novelty.

Sixth. In not holding that Beach's original patent application was unlawfully enlarged so as to include subsequently invented machines, including defendant's Horton patent machine.

Seventh. In holding that defendant petitioners have infringed any of the claims in suit, and in not holding the contrary and awarding costs to defendant petitioners.

BEACH'S PATENTED MACHINE AND ALLEGED INVENTION.

The object of Beach's invention is set forth (Record, p. 438) in his specification as follows:

> "It has been customary heretofore in making paper or strawboard boxes to apply a stay or fastening strip over the joints at the corners of the boxes, which strip is pasted down on the outside of the box,

"Or is folded over the edge of the box and secured by paste both outside and inside the corner, and such work, so far as I am aware, has heretofore been done by hand."

"My invention relates to a machine for doing this work; and consists in the matters hereinafter set forth and pointed out in the appended claims."

CLAIMS IN SUIT.

"1. The combination, with opposing clamping-dies having diverging working-faces, of a feeding mechanism constructed to deliver stay-strips between said clamping-dies, and a pasting mechanism for rendering adhesive the stay-strips, said clamping dies being constructed to co-operate in pressing upon interposed box-corners the adhesive stay-strips, substantially as described.

Elements:
1. Dies.
2. Feed.
3. Paster.

"2. The combination, with opposing clamping-dies having diverging working-faces, said clamping-dies being arranged to co-operate in pressing adhesive fastening-strips upon interposed box-corners, a feeding mechanism constructed to feed forward a continuous fastening-strip, and a cutter for severing the said continuous strip into stay-strips of suitable lengths, substantially as described.

1. Dies.
2. Feed.
3. Cutter.

"3. The combination, with opposing clamping-dies having diverging working-faces, said clamping dies being arranged to co-operate in pressing an adhesive fastening-strip upon the corner of an interposed box, a feeding mechanism constructed to feed between the dies a continuous fastening-strip, a pasting mechanism for applying adhesive substance to the strip, and a cutter for severing the strip into stay-strips of suitable lengths, substantially as described.

1. Dies.
2. Feed.
3. Paster.
4. Cutter.

"6. The combination of opposing clamping-dies having diverging working-faces constructed to co-operate in pressing an adhesive stay-strip upon an interposed box-corner, one of said clamping-dies being constructed to act with an elastic or yielding pressure to enable the dies to operate upon box-corners of different thicknesses, substantially as described."

1. Dies, one of which "acts" elastically.

☞The attention of the Court is now requested to the following facts:

First. That the Beach patent *machine as a whole* stays the interposed box-corner by (*a*) sticking the end of the stay first on the *outside* of the box-corner; (*b*) by then bending a projecting part of the stay *across* the edge of the box-corner; and (*c*) by then *turning* a short projecting part of the stay *inwardly into the box* and sticking the inturned portion of the stay on the *inside* of the box-corner. This process and product are shown by Figs. 8, 9 and 10 of the Beach patent.

Second. That the claims *not* in suit contain certain elements additional to the elements of claims 1, 2 and 3, the additional elements being the "secondary plunger or strip-bender H" which bends the projecting end of the stay across the edge of the box-corner, and the "die I" which pushes the bent end portion of the strip within the box and presses such inturned portion against the inside of the box-corner. The part H reciprocates vertically and may be called the *down-turner*, and the "die I" reciprocates horizontally and may be called the *in-turner*.

Third. The complex "form B" upon which the box is placed in the Beach patent machine is made with a V-recess in its upper portion (Figs. 2 and 3 of the Beach patent), this V-portion of the form B being an empty space when the in-turner I (which is quadrangular in cross-section and slides in and fills the V-space of the form B) is drawn back, preparatory for moving inwardly and pushing the down-turned portion of the stay inside the box. When the in-turner I is in its forward position it fits and fills the V-space of "form B," and its upper corner then forms the apex on which the box-corner is actually supported during the pressing operation.

☞That is, in exact fact,—the thing which in the Beach patent actually supports the box-corner during the pressing operation is the *horizontally reciprocating* in-turner I.

Fourth. Beach's specification states (Record, p. 443):

> "In many boxes the stay is simply pasted against the exterior surface of the box-corner and is not turned in or over the edge of the same, in which case the work can be done by using a non-reciprocating lower die or anvil and a single upper die or plunger. In such case the form B will obviously not be necessary as a part separate from the die; or, in other words, a single lower die or form will take the place of the form B and movable lower die I."

Fifth. The foregoing statement did not appear in the original application (pp. 200-203). On the contrary, Beach's original specification stated, p. 200:

> "It is customary in making paper boxes to apply a strip over the corners which is pasted down on each side *and the overlapped end is turned under the under side.* Such work, so far as I am aware, has heretofore been done by hand. **My improvement consists of a machine to do this work, constructed, arranged and operated as hereinafter described.**"

Sixth. Beach originally made three claims (p. 203), each of which was limited to mechanisms for down-turning and in-turning the overlapping or projecting end of the stay-piece. **Beach's original application contained no suggestion of inventorship of the subject-matter of the four claims in suit.**

Seventh. ☞Beach did not suggest an *allowable* claim for the subject-matter of claims 1, 2 and 3 until February 23, 1887 (p. 212), and even this seemingly allowable claim was specifically held (p. 229) by the Commissioner of Patents, on December 26, 1890, to be non-patentable unless the broad term mechanism were qualified by some such expression as "substantially as described"; and on December 26, 1890, the claim in question and its variants were rejected by the Commissioner of Patents, as appears at line 10, p. 230; and

it was not until after Beach had, on December 31, 1890, stated that he understood that his claims in question were to be limited in respect of each elemental mechanism by the words "substantially as described," to be understood after each recited "mechanism," that the Commissioner allowed claims 1, 2 and 3.

Eighth. Beach testifies that his first machine was constructed in the fall of 1885 and that it was used publicly in the spring of 1886, and that this machine contained the mechanisms recited in claims 1, 2, 3 and 6 of his reissue.

Beach, X-Ans. 9-17, pp. 81, 82.

Consequently Beach's machine was in public use for more than two years before he filed a legal claim for the subject-matter of claims 1, 2 and 3.

Ninth. The petitioners' (Horton patent) machine (specifically, Defendants' Exhibit Horton's Original) was completed "about the last of September, 1889," and was then publicly used and exhibited to many persons from various parts of the country, interested in the manufacture of paper boxes.

Horton, Ans. 1-16, pp. 24-26, and X-Ans. 37, p. 29; X-Ans. 42, p. 30; X-Ans. 49, 52, p. 31; R.D. Ans. 87, p. 36.

☞ Beach talked with Horton about the Horton machine "in the winter or spring of 1890."

Horton, X-Ans. 55-62, p. 32; X-Ans. 74-76, p. 34.

This is not denied.

Tenth. When, on November 7, 1890 (more than five years after filing), Beach presented his subsequently patented claims, he asserted (p. 229):

> **"Said claim [1] clearly avoids the only prior patent cited, to wit, that to Cohn, and is at the same time in such form as to cover other machines which have been devised since applicant made his invention. . . ."**

☞ This was six months or so after Beach had admitted knowledge of the existence of the Horton machine.

Eleventh. Defendants' Horton patent was applied for and granted during the pendency of Beach's original patent application, and without the declaration of any interference.

Twelfth. All the alleged infringing machines stay the box-corners on the outside *only*, and do not have any devices for *down-turning and in-turning* the stay. That is, they do not have either the strip-bender H, reciprocating die I, or recessed box-form B of the Beach patent; nor do they have anything comparable to the reciprocating parts H and I, or to the *recessed* box-form B.

Thirteenth. The Beach machine is a side-feed machine, the strip being fed *crosswise of the apex* of the box-support. Defendant's alleged infringing machines are back-fed machines, the strip being fed *lengthwise of the apex of the box-support.*

Fourteenth. The machine of the Beach patent cannot be modified from a side feed machine for staying without, across and within, into a back-feed machine for merely staying on the outside only, without mechanical changes of which the patent contains no recipe whatever as to how the patent machine may be converted into a back-feed machine. As shown in Beach's patent, the down-turner H, in-turner I, its tail-piece *i*, are all in the way of a feeding mechanism so arranged as to feed the strip in from the back-side of the machine towards the front, lengthwise of the apex of the box-support. The presence of the upward projection *i* of Beach's horizontally reciprocating in-turner I absolutely prevents a strip from being fed, as in defendant's machines, — lengthwise of the apex of the interposed box-corner.

☞ Beach's patent contains no disclosures as to *how* his machine may be reconstructed from a side-feeding machine, staying without, across and within, into a back-feed machine staying on the outside only.

BRIEF OF ARGUMENT.

I. Beach's reissue in suit is invalid because issued without statutory warrant and in violation of the reissue statute.

So far as pertinent to the facts at bar, Sec. 4916 Rev. Stats. is: "WHENEVER ANY PATENT IS INOPERATIVE OR INVALID, *by reason of a defective or insufficient specification*" . . . a reissue may be obtained as provided.

It clearly appears below that Beach's original patent was neither inoperative nor invalid to any extent or in any degree whatsoever. The statute does not authorize *any* reissue whatever unless the original *patent* is either "inoperative or invalid." (U.S. Rev. Stats., 4916, line 1.) All decisions to the contrary are in violation of the clear and express words of the statute. This Court has never decided this point. It is submitted that the Courts have wholly and plainly erred in sustaining Beach's reissue. The original patent drawings contained a draughtsman's error (see Beach Reissue File-Wrapper, p. 289) in one figure,—an obvious error, Beach testifies. The Commissioner had no *final* jurisdiction over the first and fundamental question of whether Beach's original patent was "invalid or inoperative." The statute is clear—there *shall be no valid reissue whatever unless the original patent is, as a* PATENT, *either invalid or inoperative.* If Beach's original patent were in suit and it should be argued that it was either invalid or inoperative in any respect whatever, the advocate would be laughed out of court.

> "A draughtsman's error can not militate against a patent."
>
> *Consolidated Brake Shoe Co.* v. *Detroit Steel & Spring Co.*, 59 Fed. Rep. 903.

In *Giant Powder Co.* v. *California Vigorit Co.*, 4 Fed. Rep. 720, Mr. Justice FIELD perceived the exact point now raised. The learned Justice observed, at pp. 724, 725:

> "Suppose, for illustration, that the specifications in two patents, the original and the reissue, were identical in their language, or, differing in phraseology, were identical in meaning, would it be pretended that, *though* their identity would be thus manifest on their face from a comparison of the two, and that *the Commissioner, in granting the reissue, had accordingly acted in a case not warranted by the statute*, it must be assumed that the reissue was properly granted, and that the action of the Commissioner could not therefore be questioned? The decisions support no such conclusion."

"It is not for courts to tamper with the words of a statute." (157 U.S. 37, 38; see also 2 Cranch, 358, 385.)

See also, Walker on Patents § 221 et seq.

Beach's Testimony Respecting Original and Reissue.

Mr. Beach testifies (pp. 105 and 106) as follows respecting the error on account of which the reissue was obtained:

"Cross-Int. 54. Do you think that any person skilled in the art of making paper box machinery would have any substantial difficulty in fully understanding the machine set forth in your original patent, No. 447,225, from the drawings and specifications thereof?

"Ans. I do not.

"Cross-Int. 55. The construction and operation of your patented machine and the nature of your invention, and all the features thereof, were set forth in your original patent, No. 447,225, with substantial accuracy, were they not?

"Ans. I supposed they were.

"Cross-Int. 56. And you still think so?

"Ans. I still think so.

"Cross-examination closed.

"*Redirect examination by* Mr. DANE.

"Redirect Int. 57 [58]. What principal defect caused you to reissue the patent upon which this suit is based?

"Ans. An error in the drawings.

"Redirect Int. 59. Who made the error?

"Ans. The draughtsman who inked the drawings.

"Redirect Int. 60. **Was it or not an obvious error?**

"Ans. **It was.**"

Therefore, petitioners contend that the Beach reissue is void because granted without statutory warrant, and that the point is open to them as a defence because the Commissioner of Patents can not be the final judge of the question whether his action in granting the reissue was or was not warranted by statute,—a question of law, pure and simple, being involved.

Patent in Suit Has Expired.

II. It is shown *infra* that the expired Reed-Jaegar British patent of April 5, 1888, shows *or* claims everything shown *and* claimed in the Beach reissue in suit. This patent is herein referred to as the Jaegar patent, Jaegar having communicated the invention to Reed.

The expiration of the British patent to Jaeger, No. 5073 of April 5th, 1888 (Record, pp. 418-424), on April 5th, 1892, terminated Beach's reissue in suit on April 5th, 1892. It is true that the Jaegar patent "expired on the 5th of April, 1892, through non-payment of the fourth year's renewal fee," as stated in "Defendants' Exhibit Certificate of Controller General of Patents," etc.,

Record, p. 304.

But it is also true that this British patent of April 5th, 1888, was applied for and was issued during the pendency of Beach's original United States patent No. 447,225, which was applied for June 10, 1885, and which was granted February 24, 1891.

A serious question arises. Did the expiration of the Jaegar patent, through non-payment of the fourth year's renewal fee, terminate Beach's original patent No. 447,225 on April 5th, 1892? Respecting this question, it is noted that Sec. 4887, Rev. Stats., refers to inventions which have "been first *patented or* **caused** *to be patented in a foreign country*," so that it is wholly immaterial whether this Jaegar British patent was or was not communicated to Reed by the same Jaegar who was defeated by Beach in an interference in the United States Patent Office; or whether or not this British Jaegar patent shows or does not show the subject-matter of that Jaegar application which was in interference with Beach's original patent application. There is no proof in the record as to the identity of the British patentee Jaegar with the Jaegar who had been defeated by Beach in the prior interference; nor is there any proof as to the identity of the subject-matter of the Jaegar British patent with the subject-matter of the Jaegar United States application with which Beach's original application had been in interference.

The first point submitted is that Sec. 4887 in very terms applies

not only to inventions previously patented abroad by the actual inventor, but also to inventions previously "*caused to be patented*" *abroad*. As is well known, a valid British patent may be granted to the first introducer within the realm whether he is the inventor or not.

The next point is that the Jaegar British patent was in law a prior patent to Beach's original patent, for the reason that it was applied for and issued during the pendency of Beach's original patent application. (*Bate Refrigerating Co.* v. *Sulzberger*, 157 U.S. 36.)

> "Was the Bate invention patented abroad before it was patented in this country? If so, the American patent expired with the foreign patent, and thereby the American public became entitled to use the *invention* from the time the foreign public were permitted to use it. . . . But the American patent will be granted on the condition that if you obtain the foreign patent first [or, if according to Sec. 4887, it is 'caused to be patented' abroad first] your invention shall be free to the American people WHENEVER, by reason of the expiration of the foreign patent, it becomes free to people abroad."

Jaegar British Patent and Beach Patent Substantially Identical.

That the invention set forth in Beach's original and reissue patents became free to the people of Great Britain on April 5, 1892, when the Jaegar British patent expired, is clear; for—

1. At the Circuit, defendant's expert Fowler testified that the Jaegar British patent contained the combinations of Beach's 1st, 2d, 3d and 6th claims in suit;

> Fowler, Ans. 7, Rec., p. 184,

and complainant's counsel instructed his expert, Brevoort, as follows when testimony in reply was taken:

> "You may exclude from your consideration the English patent to Jaegar No. 5073 of April 5th, 1888."
>
> See Int. 3 to Brevoort, Rec., p. 186.

2. Comparison of the eight claims of Beach's original letters patent with the expired Jaegar patent shows:

Beach's 1st, 2d and 3d claims are substantially the same as Jaegar's 1st, 7th and 11th claims.

Beach's 1st claim comprises dies, feed and paster. Jaegar's 11th claim comprises dies, feed and paster.

Beach's 2d claim is for dies, feed and cutter. Jaegar's 1st claim comprises only dies, feed and cutter.

Beach's 3d claim is for dies, feed, paster and cutter. Jaegar's 7th claim comprises dies, feed, paster and cutter.

Beach's 4th claim is substantially the same as Jaegar's 2d.

Beach's 5th claim is substantially the same as Jaegar's 6th.

Beach's 6th claim has no counterpart in the Jaegar patent, but the subject-matter of Beach's 6th claim is fully shown in the Jaegar patent.

Beach's 7th claim is substantially the same as Jaegar's 6th.

Beach's 8th claim is substantially the same as Jaegar's 6th.

Therefore the invention disclosed by the Beach patent became free to the people of Great Britain on April 5, 1892.

There is no evidence whatever in the record that there was more than one foreign patent setting forth the invention of the Beach patent; and consequently the plain language of Sec. 4887 requires a decree that the Beach reissue in suit expired April 5th, 1892. The statute imperatively requires that—

> "*Every patent* granted for an invention which has been previously patented in a foreign country shall be so limited as to **expire** *at the same time* with the foreign patent."

The British Controller General certifies, in this case, that the Jaegar British patent *expired* April 5th, 1892; and in *Bate R. Co.* v. *Sulzberger*, *supra*, this Court held that Sec. 4887 involves the expiration of the American patent "*Whenever* by reason of the expiration of the foreign patent it becomes free to people abroad." The decision in *Pohl* v. *Anchor Brewing Co.*, 134 U.S. 385, appears to be in direct conflict with the decision in the Bate case, because if Sec. 4887 requires the expiration of the American patent

"*Whenever* the invention of the prior foreign patent becomes free to people abroad," then it makes no difference whether the foreign patent *expires* by reason of the expiration of its potential term or *expires* earlier by reason of failure to pay renewal fees.

It is respectfully submitted that Sec. 4887 is fully and correctly construed in the Bate case and that the word "term" in Sec. 4887 refers not to the potential term of the foreign patent, but to the *effective* term thereof, and the judgment of the Court on this point is respectfully prayed.

And what was the "term" of Jaegar's British patent? The British statute is alone competent to answer that question — and the statute, 1 Stat. 46 and 47 Vict., Ch. 57, Sec. 17, is:

> "17. *Term of patent.* (1) The term limited in every patent for the duration thereof shall be fourteen years from its date. (2) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times."
>
> Abbott's Patent Laws, etc., Vol. 1, p. 223.

Is it not evident that the British statute regards the "Term of patent" as either fourteen years fixed for possible duration, or any shorter period dependent on "prescribed payments within the prescribed times;" and is it not clear that the phrase "shortest term" in Sec. 4887 regards the actual term of the foreign patent? If not, why the expression "expire at the same time with the foreign patent"? Why does Sec. 4887 provide for any expiration of an American patent at all, in consequence of the expiration of a previous foreign patent, if it does not regard the date of actual expiration rather than the date of the expiration of the potential term of the foreign patent?

Sec. 4887, R.S., expressly provides for the cessation of the American patent monopoly whenever the invention is (1) first patented, or (2) caused to be patented in a foreign country; and then it says that "Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to *expire at the same time with the foreign patent.*"

Sec. 4887, fundamentally considered, contemplates the length of time the American patent shall be *in force*, and we submit that the word "term" in Sec. 4887 relates to the *forceful* term of the prior foreign patent and not to its potential term, as held in *Pohl* v. *Anchor Brewing Co.*

Bate Refrigerating Co. v. *Sulzberger* does not refer to the Pohl case, which, however, we suppose to be overruled by the Bate case because, at p. 36, the Court says:

> "No words are used that will justify the Court in holding that an invention *patented* in a foreign country before being *patented* here, is to be exempt from the operation of the provision limiting the term of the American patent to *expire with the foreign patent.*"

The "term" of a British patent is a variable one, from four to fourteen years, dependent on the prepayment of "*renewal*" fees. In the Pohl case, German and French patents only were considered; and it does not appear that either the German or French patent laws contain any statutory definition of "term of patent" as is the case in British patent law.

☞ **Note: For aught to that appears of record, Jaegar may have been Beach's assignee. If not, it was incumbent on Beach to prove the fact in order to sustain that burden of proof which is on a complainant in order to make out a case of infringement.**

Claims 1, 2, and 3 in Suit Limited to Specific Mechanisms Recited because of Beach's Acquiescence in Repeated Rejections of the Claims Broadly Considered.

III. The 1st, 2d and 3d claims in suit, if valid, must be limited to their specific mechanisms in view of limitations imposed thereon by the Commissioner of Patents as conditions precedent to allowance. The foregoing proposition has been ignored in:

Beach v. *The American Box Machine Co., Horace Inman et al.*, 63 Fed. Rep. 597 (COXE, D.J.).
Inman Mfg. Co. v. *Beach*, 18 C.C. App. 165.
Beach v. *Inman*, 75 Fed. Rep. 840.
Inman v. *Beach*, 24 C.C. App. 408.

In these Second Circuit cases, it was finally held that Beach's 1st, 2d and 3d claims cover the therein recited mechanisms "*without any restriction whatever to the details of mechanical construction.*" (*Beach* v. *Inman*, 18 C.C.A. 169.)

But the Court of Appeals for the First Circuit, in the present cause, held:

> "It would be giving too broad a construction to the Beach patent to hold that it covered every combination of clamping dies, feeding, pasting, and cutting mechanism which accomplished the same result."

At the Circuit, in the present cause, his Honor Judge PUTNAM refused to follow the decisions of the Second Circuit, holding that the Second Circuit interpretation of the 1st, 2d and 3d claims was "a dictum and unsupported by authority." (*Beach* v. *Hobbs*, 82 Fed. Rep. 916.) The ground of this refusal was, as stated by Judge PUTNAM, 81 Fed. Rep. 927 (at top):

> "The Commissioner of Patents, by his communication of December 26, 1890, required that the words 'substantially as described' should be used to limit the word 'mechanism' wherever the word 'mechanism' occurred; but the complainant replied, Dec. 31, 1890, that this was unnecessary, because, as he stated, 'it is perfectly clear that the words "substantially as described," found at the end of each claim, refer to each and every part mentioned in the claim.'"

NOTE: The Second Circuit decisions were all against Inman or his companies, and Inman was a defeated interferent. The Courts said that Inman must stop after his eight years of unsuccessful litigation with Beach.

Beach's File-Wrapper and Contents Reviewed.

Beach's original claims were three in number, and each was for a combination for staying without, across and within. (Record, p. 203.) In the first Office action (p. 204) of Aug. 20, 1885, certain objections were made by the Examiner, and Beach amended (p. 205) on May 4, 1886, by inserting in the specification:

> "In some cases with the use of thin stays, the edge that projects beyond the edge of the box will be turned down sufficiently by the action of the plunger G and without the use of the secondary plunger H, to enable the follower I to catch it and turn it under the edge of the box; but in ordinary work where said edge is to be turned down and carried under the edge of the box, the follower is necessary. In many boxes the stay is simply pasted down over the corner of the box and is not turned under, in which case the work can be done by using the angular form and one plunger with the corresponding angular notch."

Yet, in his original application, Beach had stated (see bottom of p. 202 and top of p. 203):

> "In some kinds of work the stay can be applied *and the projecting end turned under* without the use of the secondary plunger H; but in ordinary work it is necessary."

In this amendment of May 4, 1886, Beach submitted the following, among other claims:

> "1st. In a machine for attaching stays to boxes, the combination of a form of *angular*[1] shape presenting a corner to receive the corner of the box and a plunger provided with a corresponding *angular*[1] notch which fits the form and pastes the stay to *both angular sides* of the box and over its apex, as described."
>
> Record, p. 205.

On September 3, 1886, the Commissioner held,—

> "Claim 1 should include means for applying the paste to the

[1] "Angular" dies enlarged to "dies having diverging working faces."

stay. As at present stated it is met by J. Cohn, 148,416, March 10, 1874, Box Machines, and is rejected."

Record, p. 206.

In reply Beach filed the following on Nov. 10, 1886:

"1st. In a machine for attaching stays to boxes, the combination of a form of *angular*[1] shape to receive the corner of the box; a plunger provided with a corresponding *angular*[1] notch which fits the form to paste the stay to both sides of the box, *and a pasting apparatus that pastes one side of the stay before it reaches the form*, as set forth."

Record, p. 207.

To this the Commissioner objected on November 16, 1886,—

"'Apparatus,' line 9 of claim 1, should be qualified by some such expression as 'substantially as described.'"

Record, p. 208.

In compliance with this requirement Beach stated November 23, 1886;

"Insert after word 'apparatus,' the words 'substantially as described,' line 9 of claim 1."

Record, p. 209.

On January 28, 1887, the Commissioner held that the combination of claim 1 was incomplete:

"To complete the combination and make it operative it should include as elements, '*the feeding mechanism substantially as described*,' and '*the cutting mechanism substantially as described*.' THE CLAIM AS IT NOW STANDS IS REJECTED."

Record, p. 211.

Beach thereafter filed the following substitute claim, March 5, 1887:

"1st. In a machine for attaching stays to boxes, the combi-

[1] "Angular" dies enlarged to "dies having diverging working faces."

nation of a form of *angular*[1] shape to receive the corner of the box, a plunger provided with a corresponding *angular*[1] notch which fits the form to paste the stay to both sides of the box, a feeding mechanism to feed the strip along, a cutting mechanism to cut the strip, and a pasting mechanism to paste one side of the strip before it reaches the form, *said mechanisms being substantially as described, and the whole operating in the manner* and for the purpose specified."

Record, p. 212.

The next Patent Office communication, on March 7, 1887, was the declaration of an interference with Marshall; and to the careful phraseology of the "issue" therein the attention of the Court, for two reasons, is particularly requested: 1. Patent Office rule 95, then, as now, required, "Before the declaration of interference . . . the invention which is to be the subject of the controversy must be decided to be patentable . . . ;" 2. Rule 116 then provided, as rule 122 now provides, for motions by interfering parties to dissolve on the ground of non-patentability of the issue.

The Beach-Marshall Interference Issue Defines the Commissioner's Decision Respecting Patentability; and Limits Each "Mechanism."

There is no evidence that Beach did not fully acquiesce in the Marshall issue, which was formulated by the Commissioner as stating what was patentable:

"In a machine for applying stay pieces to the corners of paper boxes, the combination of a rest or support for the corner of the box, *a feeding device substantially as described* to project the end of a continuous[2] *strip* of paper or cloth over the corner of the box on said rest, *cutting mechanism substantially as described* for severing a stay piece from the end of said strip of paper or cloth, *means substantially as described* for applying an adhesive substance to the strip or stay piece, and a plunger for

[1] "Angular" dies enlarged to "dies having diverging working faces."
[2] *Continuous* strip, as distinguished from separate stays.

pressing the severed stay piece on the corner of the box, substantially as described."

Record, pp. 213-214.

In the above issue, the limitations of the feeding, cutting, and severing mechanisms previously enjoined upon Beach were clearly stated by the Commissioner as essential adjuncts of patentability; and in the three succeeding interferences with Jaegar, with Knowlton, and with Inman, precisely the same limitations were imposed upon the issues formulated by the Commissioner as defining not only what was patentable, but also as stating necessary limitations of the claims.

The Marshall interference was declared March 7, 1887 (p. 213); and the notice of allowance was sent to Beach April 28, 1887 (p. 214). The final fee was paid September 26, 1887 (p. 215), but the case was withdrawn from allowance, on account of another probable interference, on September 27, 1887 (pp. 215-216).

On December 27, 1887, an interference was declared (p. 217) with one Jaegar. This interference contained two issues, with the limitations above noted. On February 15, 1889, Beach's application was put into another interference with one Inman (p. 218). In the issue of this interference, the same limitations were imposed upon the recited mechanisms, and on February 15, 1889, another interference was declared with Inman, and in the issue of this interference (p. 219) the same limitations were imposed upon the recited mechanisms.

Beach's Amendment of November 7, 1890.

On November 7, 1890, the interferences having been disposed of, Beach cancelled the drawings theretofore furnished, and substituted three new sheets of drawings; and also cancelled the entire specification and claims, and substituted therefor the specification of the allowed patent (pp. 220-229). The first, second and third claims (subsequently **rejected,** *infra* p. 22; action of December 26, 1890) of the amended specification (p. 226) were as follows:

1. The combination, with opposing clamping-dies having diverging working-faces, of a feeding mechanism constructed to deliver stay-strips between said clamping-dies, and a pasting mechanism for rendering adhesive the stay-strips, said clamping dies being constructed to co-operate in pressing upon interposed box-corners the adhesive stay-strips, substantially as described. [**Rejected.**]	Elements: 1. Dies. 2. Feed. 3. Paster.
2. The combination, with opposing clamping-dies having diverging working-faces, said clamping-dies being arranged to co-operate in pressing adhesive fastening-strips upon interposed box-corners, a feeding mechanism constructed to feed forward a continuous fastening-strip, and a cutter for severing the said continuous strip into stay-strips of suitable lengths, substantially as described. [**Rejected.**]	1. Dies. 2. Feed. 3. Cutter.
3. The combination, with opposing clamping-dies having diverging working-faces, said clamping dies being arranged to co-operate in pressing an adhesive fastening-strip upon the corner of an interposed box, a feeding mechanism constructed to feed between the dies a continuous fastening-strip, a pasting mechanism for applying adhesive substance to the strip, and a cutter for severing the strip into stay-strips of suitable lengths, substantially as described. [**Rejected.**]	1. Dies. 2. Feed. 3. Paster. 4. Cutter.

☞ **So far as ELEMENTS are concerned, these rejected claims are identical with the subsequently allowed claims 1, 2 and 3.** **(See supra, p. 4.)**

Beach's "Remarks" of November 7th, 1890; his Peculiar Feeding Mechanism Essential to Operativeness of his Kind of Machine.

And the amendment, dated November 7th, 1890, and filed November 17th, 1890 (p. 229), was accompanied by the following "remarks," found at pages 228 and 229:

"Amendments have been made both in the drawings and specifications, in order to make the same more fully and clearly show and describe the invention. The original drawings, while showing all parts of the machine, were not sufficiently full to clearly illustrate the same. Similarly, the original specification, while indicating the construction and operation of the machine, does not seem to be as full as is usually held to be desirable by the Patent Office. In amending the cases care has been used to include nothing in the drawings or specification which was not contained in the same as originally filed. The new drawings have been prepared from the same model from which the original drawings were made, and differ only in the more complete illustration of the details of the machine. *The feature which is more especially made clear is that of the 'elastic bed L.' In the original drawing this was shown only in side view, and both of the rollers 'M' and 'N' were described as acting on the stay strips, yet it did not clearly appear from the drawing that the said elastic bed is slotted or made up of a series of parallel bars, and that the lower roller N is grooved or ridged so as to bear against the stay strip between the bars.* **If the drawing and description are not made clear in this particular there is nothing to show how the said lower roller can have any effect whatever.** Similarly the lower roller is mounted in a movable frame, which is supported on a spring arm, and these parts are but imperfectly shown in the original drawings."

Therefore the elastic bed L must be understood in claims 1, 2 and 3: *National Meter Co.* v. *Board, etc.*, 149 U.S. 48; *Weir* v. *Morden*, 125 U.S. 98; *Crawford* v. *Heysinger*, 123 U.S. 589; *Clements* v. *Odorless Apparatus Co.*, 109 U.S. 641.

Final Rejection of Beach's Claims in Suit Broadly Construed.

On December 26, 1890, the Commissioner wrote (pp. 229-230):

"The last paragraph of the specification introduces matter which does not conform with either the drawings or specifica-

tions as they were at the time of filing the application, and must, therefore, be erased."

"The broad term 'mechanism,' in claims 1, 2, 3 and 7, should be qualified by some such expression as 'substantially as described.' . . .

"**Claims 1, 2, 3,** 4, 7 and 8 **are rejected**" (p. 230).

Beach's New Matter to Cover Horton's Machine. Six Months After Knowledge of Horton Machine.

The new matter to which the Commissioner objected is found at page 226, and relates to the use of "separate stay-strips previously cut to proper shape" whereby a cutting mechanism in the Beach machine might be dispensed with. This matter Beach erased December 31st, 1890 (p. 230).

On December 31, 1890, Beach inserted in his specification the following, p. 230:

"As far as the main features of my invention are concerned forms other than those illustrated of the several parts of the machine may be employed without departure from my invention. As, for instance, in place of the particular mechanisms shown for feeding or delivering fastening strips or stay strips to and between the clamping dies, or for applying paste or glue to said stay strips, other forms of strip feeding and pasting devices may be used in practice with the same general result as above described."

☞But in the "remarks" of November 7-17th, 1890, at p. 229, Beach said:

"Claim 1, as amended, corresponds practically with the issue of the interference, but is made slightly broader in terms. . . . Said claim clearly avoids the only prior patent cited, to wit, that of Cohn, AND IS AT THE SAME TIME IN SUCH FORM AS TO COVER OTHER MACHINES WHICH HAVE BEEN DEVISED SINCE APPLICANT MADE HIS INVENTION."

The bearing of these enlargements on the Horton machine is discussed later.

Beach's "Remarks" of December 31st, 1890, Contain Beach's Acquiescence in Commissioner's Ruling that Claims in Suit were Unpatentable if Broadly Construed.

This amendment of December 31st, 1890, was accompanied with other "remarks," the material portion of which is as follows, pp. 231, 232:

> "All formal amendments called for have been made except the insertion of the words 'substantially as described.' The insertion of these words is not objected to because they will necessarily change the scope of the claim, but because they will involve a useless repetition of said words in the claim. **It is perfectly clear that the words 'substantially as described,' found at the end of each claim, refer to each and every part mentioned in the claim, so that the repetition of these words after several of the descriptive clauses will in no sense change the meaning,** which will be exactly the same whether the words mentioned are repeated after the clause describing each element or are placed at the end of the claim only to apply to all. **If these words were not found at the end of the claim the objection of the examiner would be well founded,** but as the matter stands, no good reason is seen for their insertion."

It is plain that the Commissioner of Patents repeatedly required that the broad term "mechanism" of claims 1, 2 and 3 should be "qualified" by some such expression as "substantially as described." A qualification, that is, a limitation of these claims, was imposed upon Beach as a condition precedent to allowance; and when Beach thereafter stated:

> "If these words were not found at the end of the claim the objection of the examiner would be well founded,"

he thereby made a definite declaration to the public that the claims

were limited claims. No other honest interpretation, we submit, can be given to these claims in view of repeated rulings of this Court.

☞ It is obvious that Beach, in December, 1890, either did not intend to contend for broad claims or else was afraid to appeal from the Examiner on the point, hoping to obtain by indirection what the Examiner had repeatedly directly refused, viz.: broad claims, which answer the statutory requirement,—

> "Sec. 4888. Before any inventor or discoverer shall receive a patent he shall . . . *particularly point out and distinctly claim* the part, improvement or combination which he claims as his invention or discovery."

☞ This statutory requirement is a condition precedent to a valid grant. Much more so is it a condition precedent to a judicial construction which gives claims a broader scope than that clearly intended by the Commissioner's decisions.

☞ Beach cannot be said to have distinctly claimed his combinations of claims 1, 2 and 3 unless they be limited as intended and reiteratedly required by the Commissioner.

> "In patents for combinations of mechanism, limitations and provisos imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed *against the inventor and in favor of the public*, and looked upon as in the nature of disclaimers."
>
> *Sargent* v. *Hall Safe & Lock Co.*, 114 U.S. 63-86.

And it is submitted to this Court with great confidence that no sound lawyer, having full knowledge of the Supreme Court decisions, could soundly, upon investigation of the file-wrapper and contents of Beach's original patent, come to any other conclusion respecting the claims here in suit than that they were limited claims; and this is especially true in view of the fact that it appears from the face of the Beach patent that the product of the machine, *qua* product, was old. The Beach patent states that it was old before Beach's invention to stay boxes by hand, and therefore the product, *per se*, was

old. The machine stayed box may be better or worse than the hand stayed box, but the paper stayed box was old. Moreover, the Cohn patent, held by the Patent Office to be a pertinent reference and accepted by Beach as a pertinent reference, is a machine for inserting corner *metal* clasps of boxes, **and it was old to stay paper box corners with paper or muslin mechanically,** as shown hereafter by reference to the Maxfield and Terry patents.

In *New York Belting and Packing Co.* v. *Sibley*, 15 Fed. Rep. 389, Mr. Justice GRAY, and his Honor the late Judge LOWELL, with great wisdom and great force stated:

> "It has been several times decided by the Supreme Court that disclaimers, qualifications and limitations, imposed upon a patentee by the Patent Office, are forever binding upon him if he chooses to accept a patent containing them. Not only are third persons likely to be misled to their injury by any subsequent enlargement by reissue, or *by a broad construction of claims thus intended to be limited*, but these qualifications are conditions precedent, without which there would have been no grant at all, and, of course, the grant must be taken as it is given. If the applicant considers the case important enough, he may refuse to take a limited patent, and being then rejected altogether, may apply to the Supreme Court of the District of Columbia, under Rev. Stat., Sec. 4911; and if still dissatisfied, he has his remedy in equity by section 4915. *These remedies are ample, and they are exclusive under the decisions cited by the defendant.*"

In *Boyden Power Brake Co.* v. *Westinghouse Power Brake Co.*, 17 C.C.A. 440-441, the Court held:

> "The phrase 'substantially as set forth' is technical, and is equivalent to saying, 'by the means described in the text of the inventor's application for Letters Patent as illustrated in the drawings, diagrams, and models which accompany the application.' These words limit the general terms of the specification which set out the function performed by the invention, and con-

fine the inventor's rights to his own special means of performing the function."

And when this Westinghouse case came up to this Court on certiorari, if the decision (170 U.S. 556, 557, 558) be not misunderstood, it was held in substance that there is no authority for construing a patent to be for recited mechanisms "without any limitation whatever to mechanical details;" and that the words "substantially as set forth" have been uniformly held by the Supreme Court to import into the claims the particulars of the specification.

In this Westinghouse case, this Court also stated:

> "To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent his function";

And as said above the Beach product was old; the use of gummed strips mechanically applied to paper box corners was old; and the manual process of cutting, gumming and pressing stay pieces was old. Beach is not a pioneer, and to give him a patent for his mechanical functions, as in the Second Circuit, is a travesty on the law.

> "When, in order to obtain an allowance of a claim, it is amended by the insertion of certain limiting words, it cannot afterwards be construed to be the same as the original claim. To hold that words inserted with such formality mean nothing is going beyond any reported authority."
>
> *Beale* v. *Spate*, 74 Fed. Rep. 869.

> "The last clause of the above claim, 'substantially as and for the purpose set forth,' throws us back to the specification for a *qualification of the claim, and the several elements of which the combination is composed.*"
>
> *The Corn Planter Patent*, 23 Wall. 181-245.

In *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U.S. 425:

> "It is insisted in this connection, however, that under the words 'substantially as described' the patentee is entitled to

claim a band of oval or oblong shape, and that, looking at his specification and drawing in connection with the claim, it is obvious that the latter should be so limited. But the patentee having once presented his claim in that form, and the Patent Office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claim, *or such a construction of his present claim as would be equivalent thereto. Leggett* v. *Avery*, 101 U.S. 256. *Shepard* v. *Carrigan*, 116 U.S. 593. *Crawford* v. *Heysinger*, 123 U.S. 589, 606. *Cartridge Co.* v. *Cartridge Co.*, 112 U.S. 624."

Limitation and Non-Patentability — Prior Analogous Machines and Patents.

IV. and V. It is submitted that upon a proper consideration of prior analogous machines and patents the conclusion must be that Beach's claims 1, 2 and 3 are either strictly limited to his specific mechanisms, or else that claims 1, 2 and 3 are for non-patentable subject-matter. The latter is the sounder conclusion.

Bearing in mind that a machine patent is not to be interpreted for a function (*Boyden P. B. Co.* v. *Westinghouse*, *supra*); that it does not require invention to make dies of any particular shape (*Butler* v. *Steckel*, 137 U.S. 29, and cases cited); that "where the combination is not only of old elements, but of old results, and no new function is involved by such combination," it is not patentable (*Specialty Mfg. Co.* v. *Fenton Mfg. Co.*, 174 U.S. 498), the following prior patents are submitted as clearly showing non-patentability of claims 1, 2 and 3; or if the Court find otherwise, limitation thereof to precise details:

☞ **In the Paper Box Art we find:**

The Cohn Patent of 1874.

Page 356.

The Cohn patent machine, like the Beach patent machine, comprises clamping dies having diverging working faces. It automatically feeds separate *metallic* stays, one by one, to and forces them

upon the corner of a box supported between clamping dies having diverging working faces.

The Haddan Patent.

Page 391.

The Patent Office did not cite, but should have cited, to the Beach application the old and well-known Haddan British patent, No. 16,137 of 1884, for improvements in wire-stitching machines or machines for binding books and similar objects with metallic staples. **The Haddan patent specifically includes the staying of pasteboard boxes and shows a modification for that purpose.** (See p. 392.)

(See Haddan patent, pp. 391-393 and five sheets of drawings immediately preceding p. 391.)

This Haddan patent shows a machine which, like the Beach machine, comprises the combination with opposing clamping dies having diverging working faces, said clamping dies being arranged to co-operate in pressing a fastening strip upon the corner of an interposed box; a feeding mechanism constructed to feed between the dies a continuous fastening strip and a cutter for severing the strips into stay strips of suitable length. The Haddan patent machine contains a reel upon which a *coil of wire* is mounted, and this wire is fed intermittently between feed-rolls and thence between the members of a cutting mechanism whereby stay-pieces are cut off, and the stay-pieces are then bent staple-wise and forced through the contiguous corner-forming sides of a box by means of a recessed plunger which reciprocates towards and from an angular anvil, upon which the box-corner is supported during the operation of the machine. The Haddan patent machine, of course, contains no pasting mechanism for applying adhesive substance to the strip; but in the analogous art of paper box covering machines it had been long common, as shown in the Munro patent of 1884 (pp. 321-326 and two sheets of drawings immediately preceding p. 321) to *cover* box-corners with strips of paper or the like fed from a reel over a pasting apparatus wound upon and around the box. (See also Kingsbury patent, p. 327, for a pasting machine.)

The Inman Patent of 1884.

Page 330.

This machine presents the combination of a reel upon which the strip of paper or the like is wound and from which the strip is drawn through a pasting apparatus and then through a severing mechanism for application to a box (including its corners) mounted on the flat surface of the support, R (Fig. 1).

The Gates Patent of 1875.

Page 344.

In the Gates machine of patent 6,245 of 1875 (pp. 344-351, see Fig. 4, opposite p. 345), a *strip of paper* is automatically fed from a reel between the members of a pasting mechanism, thence between the members of an automatic severing mechanism, and thence between the stationary flat-faced work support and a therewith co-operating flat-faced reciprocating plunger.

The Gates elements are:

(1) a pasting mechanism, D, consisting of a paste reservoir and a pair of rolls.

(2) An intermittent feeding mechanism, consisting of a pair of grooved rolls, F and H, with a slotted bar between them, almost identical in construction with Beach's feeding mechanism, the special function of the slotted bar being according to the Gates patent (line 26, p. 346), to "allow the feeding apparatus to be placed some distance in the rear of the cutting and moulding devices."

(3) A cutting mechanism, S, the function of which is stated at lines 23 and 24, p. 347: "Then the cutter S is brought down and separates the end of the paper from the roll."

(4) Flat-faced dies.

In Fig. 1 of the Gates patent these parts are shown geared and otherwise mechanically connected together, and in Fig. 4 the various parts are clearly shown in section.

The details of these mechanisms are briefly set forth by Gates at pp. 345-346, and it is plain that this Gates machine anticipates

claims 1, 2 and 3 unless the limitation to "clamping dies having diverging working faces" save these claims. ☞For there is nothing else in any of claims 1, 2 and 3 which substantially distinguishes them from the prior Gates structure.

In claim 1, the final functional phrase "being constructed to cooperate in pressing upon interposed box-corners the adhesive stay-strips, substantially as described," neither adds to nor diminishes the number of elements of the claimed combination, which is for (1) opposing clamping dies having diverging working faces; (2) a feeding mechanism; and (3) a pasting mechanism.

Certainly any prior device in the box making art that presents these three elements in combination anticipates claim 1, unless a method be found in it; and such a notion of interpretation was repudiated by this Court in —

Boyden P. B. Co. v. *Westinghouse Co., supra.*

The same proposition applies to claims 2 and 3.

And it is submitted that Beach did not in claims 1, 2 or 3 do anything more than select old and well-known box-corner shaping dies and substitute them for the flat faced dies of the Gates machine, leaving off, of course, Gates' cumbersome box-conveyor which curves downwardly from one end of the table to its other end.

The paucity and tenuity of Beach's supposed invention, if any, is made clearer by the fact that Beach didn't perceive his now alleged pioneer invention when he filed his original claims.

The Sawyer Patent.

Sawyer of 1875 (p. 311) combined (in a label and tag machine) an intermittent feed; means for developing sticking material on the continuous tag strip; and suitable pressing dies.

Orr and Wright Patent.

Orr and Wright of 1866 (p. 313) set forth the combination, in the paper box art, of a pasting mechanism and a severing mechanism, forming an apparatus to be used in connection with some other box making machine.

The Orr and Wright patent was dated in 1866. It is an apparatus for paper box makers. It does not show how the gummed strips are to be applied to paper boxes, because box makers of 1866 knew how to make use of the patented apparatus. The patent states, "the stand [frame], guide-rolls, paste-rolls and shears . . . can be used in connection with a machine for covering boxes, or separately, with great advantage." The claimed invention of Orr and Wright, "The use of the shears *f* or any device which will sever paper in connection with the paper ribbon *a* and paste-rolls *d* above mentioned, as and for the purpose specified and shown," became public property in 1880.

If a Waters patent machine (see Waters' reissue of 1861, pp. 352-355) be considered in connection with the Orr and Wright machine, every element of Beach's claims 1, 2 and 3 is found, except a "feeding mechanism," for Orr and Wright show angular dies for (see claim 3, p. 355) "forming the corners of paper boxes by pressing the same between cold or hot dies constructed for purpose."

☞ Waters states that his dies may be angular or circular, and states (p. 354) that by his dies paper boxes may be made "with smooth, solid and upright corners, whereby the said boxes are greatly stiffened and rendered much stronger than otherwise made."

BEACH NOT A PIONEER.

The Maxfield and Terry Corner-Staying Machine Patents of 1866 and 1859.

Pages 394-396.

In the early days of the paper collar industry when paper collars were commonly put up in round boxes, the machines of the Maxfield and Terry patents (pages 394-398) were well-known. The Maxfield patent, in Figs. 4 and 5 (second sheet of drawings after p. 394), **shows a paper box corner exteriorly stayed with paper or muslin,** by **mechanically** forming and pressing the continuous strip against the corner formed by the vertical side and bottom of the round paper box, as described in that patent.

Maxfield states (p. 394):

"My invention relates to *mechanism for pressing* a strip of glued paper upon the **edge of a box at the junction of the bottom and sides or rim** and lid, so as to form a union of the circular end with the cylindrical side of the box;" . . . "A strip of glued or otherwise adhesive paper or material is now laid upon the angle at the junction of and lapping upon both the cylindrical side and flat bottom or end, and the handle *l* turned as the strip of adhesive material is guided. A folder, made of a piece of bent metal, as at 4, folds the edge of the strip toward and upon the edge of the circular bottom. This compression is completed by the roller *q*, while the roller *r* presses the said material firmly upon the side of the box. This strip of material forms a union of the bottom or top and sides of the box, as indicated in Fig. 4 by the blue line." . . . "In order to *cover* the box with paper of similar material it is only necessary to apply to the side of the box one end of a strip of pasted or glued material and rotate the parts, the roller *r* pressing the same against the side of the box while the turner 4 and roller *q* fold the edge over smoothly against the bottom, and at the same time a folder, 8, formed of a curved piece of metal set on a sliding stock, 9, with a spring, 10, to press it toward the edge of the box, and a spring, 11, to keep it down, turns or folds the edge of the material around into the inside of the box or lid, as seen by the red lines in the section, Fig. 5, and I employ a roller, 12, which being inside of the edge of the box, presses the said paper smoothly down to its place."

☞ Mechanical corner-*staying* and *covering* are both set forth in this patent, and are correlated operations, so that box-*covering* machines must be taken as a part of that art in which box-corner-*stay* machines are included.

In the Terry patent (p. 396) it is said:

"This invention relates to a machine that is designed to facilitate the manufacture of circular paper boxes; and it consists in the employment or use of a rotating clamp, gage, or socket, discharging-ring, pressure-roller, and guide, the above parts being

arranged substantially as hereinafter described, and used in connection with a folding-device, whereby the manufacture of the above named boxes is greatly expedited and the work done in a perfect manner."

☞ **Broadly, the mechanical parts which Maxfield and Terry show for pressing gummed paper on box corners are "dies having diverging faces."**

Thus it will be seen that not only was it old prior to the Beach patent to stay with paper angular paper box corners by hand, and also by metal stays mechanically applied to the angular corners: *but it was also old to apply by machinery pasted paper strips to the interposed corners of round boxes.* In no sense, therefore, can Beach be said to be a strictly pioneer inventor, even though his machine be the first of its particular kind for doing a specific kind of work that had been theretofore done by hand.

Prior Addressing Machine Patent to Welch.

Page 399.

Moreover, Beach, when he filed his original application, apparently recognized the fact that there was no substantial difference between his machine, in so far as the claims here in suit are concerned, and the prior addressing machine of Welch, No. 236,387, of June 4, 1881 (pp. 399-403, and sheets of drawings immediately preceding p. 399). The Welch machine is for addressing newspapers and the like, and, as appears from the face of the patent, was solicited by R. F. Osgood, who, as appears from file-wrapper and contents of Beach's original patent, was the original attorney for Beach and solicitor of that patent.

In the Welch patent (see Fig. 3, second sheet of drawings preceding p. 399), there is a reel J upon which is coiled the paper strip containing the addresses in successive order, which are to be cut and pasted upon the papers. This strip is automatically fed between the feed-rolls K and L, passed through an automatic pasting apparatus P, and thence between the members of automatically operating shears where a strip of paper containing an address is cut from the strip. The work support or follower X supports the folded newspaper, upon which the address-containing label is clamped. Welch ex-

pressly says in the middle of p. 402 of his specification that the pawl G^2 is pivoted at the rear end so that it can be turned off sidewise to disengage from the ratchet, in which case the follower may be held stationary for the purpose of labeling separate papers when desired. **The work-support of the Welch machine may, therefore, be a either vertically reciprocating work-support or a STATIONARY work-support.** The platen *f* of the Welch machine is a reciprocating plunger, which moves from and towards the work-support X to clamp the address-containing strip upon the folded newspaper on the work-support. There is, therefore, no substantial mechanical difference whatever between the machine called for by claim 3 in suit and the machine set forth in the Welch patent and specifically and clearly illustrated in Fig. 3 of that patent; except only that the opposing clamping dies of the Welch patent are flat faced instead of "having diverging working faces."

Judge Coxe on the Dennis & York Addressing Machine Patent.

In the first of the Second Circuit cases, Judge COXE, dealing with the question of patentability, apparently found some difficulty in eliminating the Dennis & York patent device, there insisted upon as a defence. The Dennis & York patent (pp. 404-407) is for an addressing machine, and was patented August 19, 1884. It was also solicited by Mr. Osgood, Beach's original attorney. The Dennis & York patent machine, while somewhat resembling the Welch addressing machine patent, is by no means so good a reference *because of the fact that Welch specifically provides for the making of his* WORK-SUPPORT *stationary* whenever desired; and, therefore, it is not true of the Welch machine, as it is of the Dennis & York machine, that, to use the language of Judge COXE, 63 Fed. Rep, top of page 601, "the bed on which the papers rest and which is the only part of the machine which bears the slightest resemblance to the lower die of the Beach patent is called 'a follower.' Instead of being rigid this 'follower,' as the name implies, is supported upon light, coiled springs and by lever action, so that it will move up and down freely and produce just enough pressure under all circumstances to receive the pasted

slip upon the upper sheet. The impact of the platen and plunger resembles the pat given to a freshly applied postage stamp. Being designed to do this light work the machine is lightly constructed and differs in many minor particulars from the Beach machine."

Judge COXE, 63 Fed. Rep. 603, stat :

> "If the Dennis & York patent does not invalidate the Beach patent none of the others does;"

and at page 602, he disposes of the contention that the substitution of angular dies for the flat dies of the Dennis & York machine does not amount to invention, on reference to such cases as the *Barbed Wire* case, 143 U.S. 275; *Magowan* v. *Packing Co.*, 141 U.S. 332; *Electric Co.* v. *La Rue*, 139 U.S. 601; and *Smith* v. *Vulcanite Co.*, 93 U.S. 486.

It does not appear from the Second Circuit decision that the Welch patent was urged. Nor does it so appear that the Maxfield and Terry patents were considered.

The Welch Patent as an Anticipation.

In the case at bar, however, the Welch patent is a much better reference than the Dennis & York patent, and the complainant's expert has made an important admission on the record herein. He says (Ans. 12, second paragraph, p. 197):

> "In the Welch patent no box could be gotten over the lower dies or support, *unless it were a very large box*, and unless the parts were altered in their operation so that the table X was *held stationary*, was reduced in diameter, or width rather."

But, in fact, Welch's work-support may be held stationary if so desired, as above pointed out.

Complainant's Expert on Requisite Degree of Angularity of Dies to Constitute Infringement.

And in answer to Q. 11, p. 196:

> "What degree of angularity must there be in the working faces of the opposed clamping dies in a box corner staying ma-

chine in order to embody the invention of the first, second, third and sixth claims of the reissue letters patent in suit?"

Mr. Brevoort, complainant's expert, says (Ans. 11):

"Each one of the claims refers in terms to an interposed box corner." . . . "I think Mr. Beach might make a die for a six-sided box, or he might make one for an eight-sided box. I name these two figures because I have seen six and eight-sided boxes, though they did not have stay strips. I do not know how far beyond this the departure might go. The patent as it stands distinguishes against flat dies and includes only dies suitable for box corners. *If the dies were flat or substantially flat in a machine, the machine could not be held under the patent.*"

☞ **Defendant's Exhibit Hobbs' Modified is identical with the alleged infringing machines, except only that it has flat faced dies instead of "dies having diverging working faces," and this fact shows clearly that there is no invention in claims 1, 2 and 3, it being old to use dies (as in the Waters patent) having diverging working faces for shaping paper-box corners, and being old (as in the case of Cohn and Haddan) to stay paper-box corners between dies having diverging working faces.**

And here it may be noted that Waters shows both non-circular dies having diverging working faces (Fig. 10) and also circular dies having diverging working faces (Fig. 11) which are expressly said (p. 353) to have "journals turning in fixed or YIELDING boxes." This is a clear anticipation of Beach's claim 6; and shows that there is no substantial novelty in either flat faced dies or circularly faced dies, or angularly faced dies, having diverging working faces, for a circle is nothing but a polygon having an infinite number of sides.

Beecher and Elliott Patent for Paper Boxes. Its Claim 5 Substantially Identical with Beach's Third Claim.

The Beecher and Elliott patent No. 281,958 of July 24, 1883, for machine for making match boxes describes and claims (p. 342):

"5. The combination of the following elements:

"Mechanism substantially as described for applying glue to a continuous strip; [**Paster**]

"Mechanism substantially as described for scoring the strip in a longitudinal direction and cutting out the excess portions; [**Cutter**]

"Mechanism substantially as described for advancing the strip with an intermittent movement scoring and cutting the same transversely; [**Feed**] and —

"Mechanism substantially as described for folding the blank thus formed into a complete box." [**Dies**]

The blank-folding mechanism mentioned includes a "bed-block" and a "former-block" as set forth in the middle of page 341. These two blocks are the particular form of dies requisite in this Beecher and Elliott machine, and are flat faced.

On the whole, it is therefore submitted that while Beach appears to have exercised ingenuity in making the combinations of claims not in suit and involving as elements the down-turner and in-turner, it is nevertheless contended that nothing more than ordinary mechanical skill, such as an ordinary mechanic is naturally expected to exercise when told to make a machine to do a stated kind of work, was involved in the production of the simple and seemingly obvious aggregations of claims 1, 2 and 3. Can it be fairly doubted, for example, that if anyone had asked Welch to make a machine for staying corners, by successively gumming, feeding, severing and pressing, he would have replied that he could do it by substituting, for the plain faced dies of his addressing machine, angular faced dies suitable for the purpose?

In view of the fact that all the elements of Beach's first three claims are shown in the same marshaled order in the Gates patent, and of the fact that the Waters patent shows the use of angular faced dies for the making and forming of the corners of paper boxes, and of the fact that the Cohn patent shows angular faced dies in combination with an intermittent feed for the purpose of staying paper box corners; and of the fact that the Haddan patent shows a box corner staying machine comprising precisely the same array of elemental

mechanisms as are shown in the Beach patent (pasting or moistening mechanism alone excepted); and of the fact that the Maxfield and Terry patents show organized machines for staying box corners with adhesive strips; and, in view of complainant's expert's admission that paper box joints might be stayed on the Welch addressing machine, it is submitted that the subject-matter of claims 1, 2 and 3 in suit do not form a combination, but, on the contrary, are mere aggregations which do not involve any exercise of the inventive faculties to produce. A finding to this effect by the Court will be in exact accordance with Beach's original specification, wherein there was no suggestion whatever of a claim for the subject-matter of the first three combinations in question.

These prior patents demonstrate that what the patentee did, so far as the claims in suit are concerned, was to adapt well-known devices to the special purpose to which he contemplated their application. It was necessary that the pasting mechanism should either apply paste or develop a condition of stickiness in a previously gummed strip; that the feeding mechanism should next feed intermittently; that the cutting mechanism should then cut off a piece of the fed stay-strip; and that the dies should then act. All this is fairly comparable to what the inventor did in *Aron* v. *Manhattan Railway Co.*, 132 U.S. 89-90. And yet the Court there held:

> "It seems impossible to doubt that any competent mechanic familiar with devices well known in the state of the art could have done this readily and successfully, upon the mere suggestion of the purpose which it was desirable to effect. . . .
>
> "The patentee is entitled to the merit of being the first to conceive of the convenience and utility of a gate opening and closing mechanism which could be operated efficiently by an attendant in the new situation. His right to a patent, however, rests upon the novelty of the means he contrives to carry his idea into practical application. It rarely happens that old instrumentalities are so perfectly adapted for a use for which they were not originally intended as not to require any alteration or modification. If these changes involve only the exercise of ordinary mechanical skill, they do not sanction the

patent; and in most of the adjudged cases where it has been held that the application of the old devices to a new use was not patentable, there were changes of form, proportion or organization of this character which were necessary to accommodate them to the new occasion. The present case falls within this category."

The Elements of Claims 1, 2 and 3 are Merely Aggregated. They are Not Combined.

The pasting mechanism performs no function that it does not perform in the Gates and Welch patents. It simply pastes or develops stickiness on an already gummed strip.

The feed mechanism performs no function that it does not perform in the Gates and Welch patents. It simply feeds the strip operated on.

The severing mechanism performs no function that it does not perform in the Gates and Welch patents. It simply severs the thing fed.

The pressing mechanism performs no function that it does not perform in the Gates and Welch patents. It simply presses the thing severed in place on the interposed work; and, in so far as it shapes an interposed box corner, its effect is wholly due to the mere appropriateness of the shape of its dies, which shape is old in the paper box art, as shown by the patents to Cohn and Waters.

No one or more mechanisms of claims 1, 2 and 3 anywise modifies or affects the action of any other mechanism. Take away any one or more of the recited elements, and every remaining element performs its full function without let or hindrance. This is obviously true and accords with the inventor's position, for there is no severing mechanism in claim 1, and there is no pasting mechanism in claim 2.

Claim 1 Void because for Rejected and Cancelled Matter.

Claim 1 does not contain any provision for severing stay-strips from a continuous strip, and is, therefore, for a mechanically incomplete combination, unless "separate stay-strips previously cut to the proper shape," as stated in the concluding paragraph of the substi-

tute specification of November 7, 1890 (Record, p. 326), are used. But, as the Commissioner required this paragraph to be cancelled (Record, p. 229) because it introduced "matter which does not conform with either the drawings or specification as they were at the time of filing the application," the claim must be held as not covering a machine in which separate stay-strips previously cut to proper shape might be used, for Beach acquiesced in the Commissioner's requirement. Consequently, the claim stands as an inoperative claim for a machine using a continuous stay-strip, unless Beach's novel theory, *infra*, be good law.

Beach testifies, in Cross-Interrogatories 39-40, that a cutting-off device in the hand of the operator would "simply take the place of the shears attached to the machine." (Beach, Ans. 39-40, Record, p. 85.)

It is therefore submitted that claim 1 in suit should be held invalid.

Claim 2 Incomplete and Inoperative.

Claim 2 in suit is confessedly for a mechanically incomplete combination of die, feeding and severing mechanism for use on a continuous strip. Under this claim, as the combination is limited to use with a continuous strip, either a pasting mechanism or a moistening roll that will moisten the sticking material on a previously gummed strip must be read into the claim. It has been strenuously contended heretofore, on the part of the complainant, that a sponge held in the hand of the operator would supply the missing element of a paste or water roll.

Claim 3 a Mere Aggregation in Absence of Thing Operated On.

Claim 3 is for an automatic machine, and comprises the die, feeding, cutting and pasting (or moistening) mechanisms. **Beach, in Cross-Answer 35 (Record, p. 84), admits that if the stay-strip be taken off his machine then the reel and the paste-roll and the feed and the cut-off, and the clamping dies are wholly independent one of the other;** and it therefore becomes apparent that, so far as claims 1, 2 and 3 are concerned, the therein recited

elements are a mere array in properly marshaled order of the several mechanisms which are jointly and severally dead parts until the stay-strip, *i.e.*, the thing operated upon, is in place; but, as a matter of law, the thing operated on is not an element of a combination (*Morgan Envelope Company* v. *Albany Paper Co.*, 152 U.S. 431-433); and it is submitted that there is no true combination involved in these claims, and also submitted that if there be a patentable combination involved in any one of these claims, it is void for want of invention, not only because in the prior addressing machine patents of—

Welch, No. 236,387, January 4, 1881, p. 399,
Dennis & York, No. 303,922, August 19, 1884, p. 404,
Zacharias, 67,833, August 13, 1867, p. 408,
Gill, 84,223, November 17, 1868, p. 410,
Bailey, 148,103, March 3, 1874, p. 412,
Farquarson, 217,685, July 22, 1879, p. 414,

in which correspondingly marshaled reel, pasting, intermittent feeding, pressing and cutting mechanisms are found: but also because the Haddan British patent No. 16,137, of December 8, 1884 (Record, pp. 391-393 and five sheets of drawings immediately preceding p. 391), shows a machine for binding objects with metallic staples, or, as stated in the Haddan specification (Record, pp. 392-393), *for connecting the edges of the pasteboard boxes with each other*, when the machine will be modified in the manner set forth by Haddan, and provided with an "angular arm A" (Haddan, p. 392) and with a "stamper plate" or vertically reciprocating die having an angular working face of requisite construction for driving the staples formed from severed stay or staple-forming pieces of an intermittently fed wire.

But if the Court be of the opinion that patentable invention may be predicated upon the subject-matter of these three claims in suit, then it is submitted, upon the authority of *Office Specialty Company* v. *Fenton Metallic Co.*, 174 U.S. 492, that inasmuch as every element of the combinations described in the first, second and third claims of the Beach reissue is found in the prior addressing machines and box-corner staying machines, these three claims are

each limited to the precise construction shown; and such a construction by the Court will be exactly consonant with Beach's statement to the Commissioner in his letter of November 7, 1890 (Record, p. 228), that the slotted elastic bed L combined with the rollers M and N, the roller N being grooved or ridged, so as to bear against the stay-strip between the bars and mounted in a movable frame, is essential to the operativeness of the machine which he disclosed to the public by his original patent.

Beach's Feeding Mechanism.

This is a peculiarly complicated mechanism apparently intended, as stated by Judge PUTNAM, to perform special functions. It is well known that a pair of rolls will feed material passed between them; but Beach, as appears above, told the Commissioner that the rolls M and N were not sufficient, and that the elastic slotted bed L, which is between the rolls, must be clearly shown in order to make his feeding mechanism effective.

In the case at bar, it is submitted that Beach's specific feeding mechanism must be held to dominate each one of the first, second and third claims in suit, not only because it was a condition precedent to allowance that the words "substantially as described" should be found after that mechanism, but also because of his insistence upon the essentiality of the slotted elastic bed L as a part of his feed mechanism.

THE SIXTH CLAIM.

"6. The combination of opposing clamping dies having diverging working faces constructed to co-operate in pressing an adhesive stay strip upon an interposed box corner, *one of said clamping dies being constructed to act with an elastic or yielding pressure*, to enable the dies to operate upon box corners of different thicknesses, substantially as described."

While his Honor Judge PUTNAM stated (82 Fed. Rep. p. 992, near bottom),—

"Claim 6 contains the pith of the complainant's [supposed] invention, *which was in the* ADAPTATION *of the clamping dies*,"

nevertheless petitioners contend that claim 6 is void for want of invention.

First. The obvious gist of claim 6 is the yielding action of one of its co-operating pressing members. Probably few kinds of machines containing co-operating pressing members, ever exhibited before your Honors, have been constructed without springs of some kind to cause one of the members to act with an elastic or yielding pressure. This mechanical expedient is universal in pressing machines.

The expedient is here shown to be old in Gates patent No. 6245 of January 17, 1875, for paper-box machines, wherein see Fig. 3, and note, spring k^3 around shank j of follower Q; and lines near the middle of column 1, p. 3, of this patent.

Record, pp. 438, 443.

Claim 6 Anticipated by the Cohn Patent.

It is also shown to be old (*in combination with "opposing clamping dies having diverging working faces constructed to co-operate in pressing" corner clasps "upon an interposed box corner"*) in Cohn's patent No. 148,416, of 1874, for machines for inserting corner clasps of boxes. See Figs. 3 and 4, and note, in second column of page 1:

"G is a yielding bed or saddle which surrounds the forward portion of arm B, and the bottom of which rests on and is secured to the forward end of a strong spring *d*."

Record, p. 458.

This Cohn patent contains every *element* of Beach's claim 6.

Cohn's dies act directly on corner clasps instead of on adhesive stay-strips. That's the only difference. Cohn shows,—

"The combination of opposing clamping dies having diverging working faces constructed to co-operate in pressing { a metallic / [an adhesive corner clasp / stay strip] } upon an interposed box corner, one of said clamping dies being constructed to act with an elastic or yielding

pressure, to enable the dies to operate on box corners of different thicknesses."

In the Haddan patent the "stamper plate *k*," which c
Beach's movable die, is attached "to the **elastic lev**
elasticity is obtained by a vertical and curved spring a
lever *i*. Consequently the Haddan machine of 1884 i
fringement of claim 6, and thereby anticipates the clai
"That which infringes if later anticipates if earlier."

☞So also the Waters machine of 1861 would be an
of claim 6, if now made and used to press a stay piec
terposed box corner, for as above noted one of his circular dies having diverging working faces has "journals turning in fixed or YIELDING boxes," and therefore that die "acts with an elastic or yielding pressure" *and on interposed paper box-corners!*

Testimony of Defendant's Expert Respecting 6th Claim.

Defendant's expert, Fowler, testifies, respecting the sixth claim, pp. 58-62, and concludes after consideration of a large number of prior patents:

> **"The feature of the alleged invention forming the essential feature of claim No. 6, viz., the construction of a clamping die so as to exert an elastic or yielding pressure, I find to be clearly shown in the several patents to which I have referred, and was, moreover, commonly employed for many years prior to the record date of the invention described in claim 6 of the patent in suit."** . . .

Complainant's Expert on Claim 6.

Mr. Brevoort's argument in favor of this claim is as ingenious as it is unsound:

> "*Int.* 6. Mr. Fowler has said that springs being old as shown in the earlier patents the application of such devices to one of

"Claim 6 contains the pith of the complainant's [supposed] invention, *which was in the* ADAPTATION *of the clamping dies*," nevertheless petitioners contend that claim 6 is void for want of invention.

First. The obvious gist of claim 6 is the yielding action of one of its co-operating pressing members. Probably few kinds of machines containing co-operating pressing members, ever exhibited before your Honors, have been constructed without springs of some kind to cause one of the members to act with an elastic or yielding pressure. This mechanical expedient is universal in pressing machines.

The expedient is here shown to be old in Gates patent No. 6245 of January 17, 1875, for paper-box machines, wherein see Fig. 3, and note, spring k^1 around shank j of follower Q; and lines near the middle of column 1, p. 3, of this patent.

Record, pp. 438, 443.

Claim 6 Anticipated by the Cohn Patent.

It is also shown to be old (*in combination with "opposing clamping dies having diverging working faces constructed to co-operate in pressing" corner clasps "upon an interposed box corner"*) in Cohn's patent No. 148,416, of 1874, for machines for inserting corner clasps of boxes. See Figs. 3 and 4, and note, in second column of page 1:

> "G is a yielding bed or saddle which surrounds the forward portion of arm B, and the bottom of which rests on and is secured to the forward end of a strong spring *d*."
>
> Record, p. 458.

This Cohn patent contains every *element* of Beach's claim 6.

Cohn's dies act directly on corner clasps instead of on adhesive stay-strips. That's the only difference. Cohn shows,—

> "The combination of opposing clamping dies having diverging working faces constructed to co-operate in pressing { a metallic / an adhesive } corner clasp / stay strip } upon an interposed box corner, one of said clamping dies being constructed to act with an elastic or yielding

pressure, to enable the dies to operate on box corners of different thicknesses."

In the Haddan patent the "stamper plate *k*," which corresponds to Beach's movable die, is attached "to the **elastic lever** *i*." This elasticity is obtained by a vertical and curved spring at the right of lever *i*. Consequently the Haddan machine of 1884 is a plain infringement of claim 6, and thereby anticipates the claim.

"That which infringes if later anticipates if earlier."

☞ So also the Waters machine of 1861 would be an infringement of claim 6, if now made and used to press a stay piece upon an interposed box corner, for as above noted one of his circular dies having diverging working faces has "journals turning in fixed or YIELDING boxes," and therefore that die "acts with an elastic or yielding pressure" *and on interposed paper box-corners!*

Testimony of Defendant's Expert Respecting 6th Claim.

Defendant's expert, Fowler, testifies, respecting the sixth claim, pp. 58-62, and concludes after consideration of a large number of prior patents:

> **"The feature of the alleged invention forming the essential feature of claim No. 6, viz., the construction of a clamping die so as to exert an elastic or yielding pressure, I find to be clearly shown in the several patents to which I have referred, and was, moreover, commonly employed for many years prior to the record date of the invention described in claim 6 of the patent in suit."** . . .

Complainant's Expert on Claim 6.

Mr. Brevoort's argument in favor of this claim is as ingenious as it is unsound:

> *"Int.* 6. Mr. Fowler has said that springs being old as shown in the earlier patents the application of such devices to one of

the dies would not amount to invention. Please state whether you agree with him in this regard?

"*Ans.* I agree with him to this extent. The application of a spring to an old piece of mechanism where the spring would be serviceable would not require invention. But in this case I think that the combination of the sixth claim is clearly distinguishable from anything in the art, because it was new to combine clamping dies having the particular form of face here recited, with a mechanism for attaching stay strips to boxes.

"Now this being a new and basic discovery of Beach's, he has an entire *right to combine with this new mechanism a spring as an element of the combination*, if that spring performs some useful work in that combination. His combination being new, the addition of the old element thereto constitutes a novelty which would not be found were the spring merely combined with some old and well-known mechanism; and, therefore, though I agree with Mr. Fowler, generally speaking, that the addition of a spring does not involve invention, I think that in this particular case the addition of a spring did involve invention, because it is found in a combination which is wholly novel outside of the spring."

☞One striking defect of Brevoort's proposition is that Beach, in claim 6, does not *combine the dies with anything whatever*. Claim 6 does not contain as an element either a pasting or a feeding, or a severing mechanism. *It does not contain even a spring as an element, but is limited to a pair of dies, one of which is "constructed* TO ACT *with an elastic or yielding pressure."* This is a purely functional claim, in the nature of a process.

It is, therefore, submitted that the sixth claim is plainly void for want of invention, and the attention of the Court is requested to the fact that there was no claim whatever based upon the elastic or yielding presser in Beach's original application; that he did not claim it in his first amendment, filed June 19, 1885; and that it was not until December 8th, 1886, that Beach made any claim whatever for the subject-matter of his present sixth claim; and then

his claim was limited to his specific construction. Afterwards it was broadened.

UNLAWFUL ENLARGEMENT.

Beach's Claims Enlarged to Cover Machine of Defendant's Horton Patent.

VI. Defendant's machine is made under, and in accordance with, the Horton patent, No. 442,582, of December 9, 1890. See pages 305-310.

Horton's first machine was completed and put into actual use in his factory at Reading, Mass., as early as September 23, 1889.

Horton, Ints. 87, 88, p. 43.
Horton, Ints. 89-92, p. 44.

This first machine was run about six months, and shown to a great many box makers,—

Horton, Ans. 2, p. 30,—

and several other similar machines were subsequently built by Horton, and sold for use in staying paper boxes in factories other than his own.

Horton, Ans. 10, p. 31.

The Horton machine became well known to the trade,—

Horton, Ans. 11-17, pp. 31, 32; Ans. 49, p. 37,—

and complainant Beach had knowledge of the Horton machine in the winter or spring of 1890.

Ans. 54-58, pp. 38, 39.

And Beach then, in conversation with Horton, "claimed . . . that a staying machine could not be constructed that would not infringe his patent." (Beach did not then have a patent.)

Horton, Ans. 70, p. 40.

It is perfectly well settled that an applicant has not a legal or equitable right to expand his invention so as to include later inventions. If Beach had entered the Office with a broad statement of invention, it is possible that he might have thereafter engrafted broad claims upon his original application. But even this is doubtful, and it is certain that there was no statement of invention, and no claim, in his original application that was broad enough to include a corner-staying machine which did not contain the strip bender H and horizontally reciprocating in-turner I. Indeed, in the case before Judge COXE, the Court states:

> *"If it could be shown that the scope of the original had been enlarged so as to enable Beach to appropriate other inventions, the rule* [in *Railway Co.* v. *Sayles*, 97 U.S. 554] *would apply. But this was not shown."*

In the case at bar, defendants call the attention of the Court to the fact that Beach, in his "remarks" of November 7, 1890, expressly stated that his first claim was drawn "to cover other machines which have been devised since applicant made his invention"; and petitioners point out to your honors that Beach did not, prior to November 7, 1890, make a claim which, upon any theory of judicial construction, could have covered the Horton machine, even if the claims in suit can be enlarged beyond their scope intended by the Commissioner when the original patent was granted.

> "The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the mean time, any more than it does in the case of reissues of patents previously granted. Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions *made prior to such alteration*, or to appropriate that which has in the mean time gone into public use."
>
> *Railway Co.* v. *Sayles*, *supra*.
> *Eagleton Mfg. Co.* v. *West Mfg. Co.*, 111 U.S. 490.

NON-INFRINGEMENT. DEFENDANTS' FEEDING AND CUTTING MECHANISMS NEW AND WHOLLY DIFFERENT FROM BEACH'S.

VII. Defendants' expert, Fowler, testifies, pp. 65-69, to the substantial and material differences between the Beach machine and the Horton patent, or defendants' machine, as follows:

"*Ans.* . . . I find the feeding and cutting mechanism [of defendant's machines] to be new and substantially different from the feeding and cutting mechanism described and shown in the patent in suit, and that the two are differently combined, and that the result produced by these two elements of the combination is new and different from the result produced by the corresponding elements forming a part of the combination described in claims 1, 2 and 3 of the patent in suit. In the machine marked 'Defendants' Infringing Machine,' the continuous strip of paper is not projected forward as in the feeding mechanism shown in the patent in suit, but is carried forward by a carrying plate, toward the cutting and clamping mechanism.

"The cutting mechanism described in the patent in suit consists of an independent device actuated by a separate cam, and requiring an adjustment in timing to correspond with the action of the other parts of the machine. In the defendants' machine the cutting is performed by the action of a *stationary lower blade* provided with a straight cutting edge, and an upper reciprocating angular or V-shaped blade, by which the opposite edges of the stay strip are simultaneously cut, and the continuous strip severed by the cutting action of the knives *from each edge towards the centre.*

"The continuous strip in the defendants' machine is fed to the clamping dies *in a line parallel with the line of the apex of the lower die or anvil*, so that the method of cutting upon opposite edges of the continuous strip allows the partially severed stay strip to be bent down at its edges and shaped to the box corner *before it is entirely severed, thereby removing all possibility of any accidental displacement of the severed strip upon the box corner.*

"The feeding mechanism shown in the patent in suit consists of a pair of rolls having an intermittent motion by which the continuous stay strip is projected or pushed from the forward side of the rolls toward the clamping dies, and during their period of rest the continuous stay strip is held stationary.

"The *upper of these feed rolls* acts in connection with the *lower feed roll* and *an elastic bed* consisting of a series of parallel wires, to move the stay strip forward. This forward movement of the stay strip is accomplished with the adhesive side next the elastic bed, producing a scraping action between the adhesive side of the stay strip and the wires forming the elastic bed.

"Any resistance to the forward movement of the continuous strip between these feed rolls and the cutting mechanism and clamping dies, such as would be produced by the clogging of the gum, or by other causes, has to be overcome by the stiffness and inflexibility of the stay strip itself.

"There is no co-operation between the feed rolls and the cutting mechanism, except that they are made to act at the proper period of time relatively to each other. The stay strip is fed *from the side of the clamping dies* and in a line at right angles with the line of the apex of the lower die or anvil, so that the cutting must be effected before one of the advancing lower corners of the upper die arrives in the horizontal plane occupied by the top of the box corner, or requiring the complete separation of the stay strip before the separated strip is shaped to conform to the box corner. The cutting action of the mechanism shown in the patent in suit takes place upon one side of the continuous strip only, and causing any undue strain in cutting to cause the displacement or lateral movement of the continuous strip.

"In the **defendants' machine the feeding motion** consists of a *carrying plate having a reciprocating motion and provided with a hinged pawl, with its point engaging the continuous strip.* This carrying plate is placed BENEATH THE STRIP and the hinge pawl above stands at an inclination to the line of motion of the carrying plate, and the pawl is provided with a

spring which presses the free end or tip of the pawl upon the upper surface of the continuous stay strip: so that, as the carrying plate moves forward toward the cutting and clamping mechanism, the spring-actuated pawl will engage the upper surface of the continuous strip and press against the carrying plate, causing the continuous strip to be moved forward with the forward movement of the carrying plate.

"Upon the reverse movement of the carrying plate, the point of the spring-actuated pawl becomes *disengaged from the continuous strip*, allowing the carrying plate to move back without reversing the motion of the continuous strip. A parallel wire is arranged over the continuous strip and in the path of the pawl, at its extreme rearward motion. This wire is so arranged as to lift the pawl, *entirely free from the stay strip at the rear part of its reverse motion*, and the carrying plate is placed sufficiently below the under surface of the stay strip as to be free from contact with it when the spring-actuated pawl is raised off from the stay strip.

"The cutting action of the blades begins at the beginning of the period of 'dwell' of the carrying plate at its forward movement, so that an incision will be made in the opposite edges of the stay-strip before the reverse movement of the carrying plate begins, thereby causing the continuous stay-strip to be locked and held during the reverse movement of the carrying plate.

"The cutting action of the angular blade and straight blade severs the strip, as I have said, upon opposite sides, allowing the centre to remain until the partially severed end is shaped into the form of the box corner.

"This peculiarity of the cutting mechanism is new, and distinguishes the cutting mechanism of the defendants' machine from the cutting mechanism described by the patent in suit.

"I am aware that a feed mechanism different in details of construction, but somewhat similar in its method of operation

to the carrying plate and spring-actuated pawl of the defendants' machine, is found in other mechanisms, such as card-setting machines, wire-stitching machines, etc., but the device employed in such machines would not be applicable to the defendants' machine *without the co-operation of the cutting dies by which the continuous stay strip is held against the reverse movement.*

. . . . . .

"I have stated that the feeding mechanism known and in use upon card-setting and book-stitching machines, and which are similar to the reciprocating plate and pawl shown in the defendants' machine, could not be used upon a stay strip adapted to be applied to a box corner, for the reason that the similar feeding devices in wire-stitching and card-setting machines depend upon the inflexibility or stiffness of the wire fed, which serves to prevent the bending or 'buckling' of the wire when resisting a pushing strain.

"In the defendants' machine this lack of stiffness or inflexibility of the continuous adhesive strip does not affect the operation of the feeding mechanism, for the reason that the stay strip during the reverse movement of the carrying plate and pawl is locked by the engagement of the cutting knives with the opposite edges of the strip, and the strip is thereby held from being moved back by any accidental friction or engagement of the feeding mechanism with the stay strip during its reverse movement.

"If the stay strip were of wire instead of a flexible material, like the gummed and moistened paper, the backward movement of the wire would be resisted by the stiffness of the wire itself, which would hold it from bending or 'buckling' between the carrying plate and the paste roll.

"This co-operation of the feeding and cutting mechanism in the defendants' machine, I find to be new and substantially different in its construction, adaptation and mode of operation, from the feeding and cutting mechanism shown in the patent in suit.

"I also find that the combination of the cutting and pressing mechanism is new and substantially different in its construction, adaptation and mode of operation, from the cutting and pressing mechanisms shown and described in the patent in suit.

"The *cutting mechanism* arranged to perform the function performed in the *defendants' machine* and co-operating with the feeding and pressing mechanism in the defendants' machine, *could not be substituted for the cutting mechanism shown and described in the patent in suit* and made a part of the combination set forth in either of the claims 1, 2, and 3 of the patent in suit.

. . . . . .

"*The cutting mechanism of the defendants' machine is made a part of the pressing mechanism* by the attachment of the movable blade directly to the reciprocating upper die, so that it is actuated and moved by the movement of the upper die and its connected actuated mechanism; **while in the patent in suit the cutting mechanism forms a separate and independent element controlled by a separate and independent cam requiring a special adjustment in the time and period of its movement, as described and set forth in the patent in suit.**"

Defendants' Machine.

In defendants' back-feed machine, the stay piece is fed in from the rear the required distance, along the apex and in the longitudinal direction of the box corner, from the top of the box towards its bottom. The feeding mechanism is a *carrier* that seizes the stay-strip and carries it bodily forward between the dies, the upper die itself performing the function of Beach's shear blade Q. *The upper or movable die acts first on opposite edges of the stay-strip, and then gradually on the intermediate portion of the stay-strip*, as the movable die descends and presses the stay-strip against the stationary blade and the severed portion against the box corner. The cutting and pressing operations are almost simultaneous, *the severing mechanism being in fact a part of the feeding mechanism* and the cutting part of the movable die practically part and parcel of that die. From

defendants' back-feed machine, Beach's hinged blade Q, vertical slide R, guide R^1, cam stud *r*, and cam E, are eliminated; and from defendants' machine, Beach's elastic bed L, grooved roller N, movable frame N^1, spring arm *n*, upper roller M, and segmental gear E^1, are eliminated, each of these two groups of Beach mechanisms being mechanically impossible of combination with pressing dies and pasting mechanism in a back-feed machine *of the Horton type*. Beach's down-turner H and in-turner I are also omitted, and these eliminations make it possible to produce a back-feed machine *of the Horton type*. The Beach patent machine shows the down-turner H and in-turner I rearwardly of the box support, where the severing and feeding mechanisms are placed in Horton's back-feed machines. While the Beach patent contains a suggestion of staying on the outside only, it does not as much as suggest that a back feed is practical nor does it contain any disclosure of a back-feed machine, an absolutely essential element of which is a severing mechanism which severs the stay piece at the very edge of the box, so as to prevent the stay from overhanging the box edge. *It is obvious that Beach's shears* P Q *could not be placed close enough to the back end of Beach's box rest to sever the stay piece without an overhang thereof.*

A Question of Substitution.

The Supreme Court holds that "This interchangeability, or non-interchangeability, is an important test in determining the question of infringement."

Miller v. *Eagle Mfg. Co.*, 151 U.S. 208; citing—
Prouty v. *Ruggles*, 16 Pet. 336.
Brooks v. *Fiske*, 15 How. 212.
Eames v. *Godfrey*, 1 Wall. 78.

It is apparent that the Beach patent machine would have to be reorganized in order to convert it into a back-feed machine; and that this involves invention is quite apparent not only from the existence of the Horton patent but more especially from the Knowlton patent No. 447,955, of March 10, 1891, in accordance with which the complainant's commercial machines have been constructed. This Knowl-

ton patent, like the Beach patent, belongs to the firm of Knowlton & Beach, whose utility witnesses all testify practically to the Knowlton & Beach machine of the Knowlton back-feed type. The Knowlton back-feed troughs the stay-strip.

Spooner, X-Q. 57-59, pp. 102, 103.
Otis, X-Q. 9-19, p. 105.
Baldwin, X-Q. 36, p. 111.
Barbour, X-Q. 21, p. 133.
Knowlton, X-Q. 24, p. 140.

All the foregoing to be read in connection with Hobbs, *Aus.* 14-17, p. 148, who testifies that the machines used by complainant's witnesses are Knowlton patent machines.

Functions of Beach's and Horton's Severing Mechanism Compared.

The severing function of defendants' machine is not performed in substantially the same way that the severing function of Beach's machine is performed.

> "Function must be performed in substantially the same way by an alleged equivalent, as by the thing of which it is alleged to be an equivalent, in order to constitute it such."

Burr v. *Duryee*, 1 Wall. 573.
Werner v. *King*, 97 U.S. 230.
Dryfoos v. *Weise*, 124 U.S. 37.
Forncrook v. *Root*, 127 U.S. 181.
Sargeant v. *Burgess*, 119 U.S. 19.
Sickels v. *Borden*, 3 Blatch. 535.
Peard v. *Johnson*, 23 Fed. Rep. 509.
Tondeur v. *Chambers*, 37 Fed. Rep. 337.
Pacific Ry. Co. v. *Butte City Ry. Co.*, 58 Fed. Rep. 420.

Neither primary nor secondary patents are infringed by any substitutions that do not fully respond to two tests: (1) identity of function; (2) substantial identity of way of performing that function.

Walker, sec. 352.

Steam Gauge & Lantern Co. v. *Rogers*, 29 Fed. Rep. 453.

Clark v. *Wilson*, 30 Fed. Rep. 373.

Butz Thermo-Electric Co. v. *Electric Co.*, 36 Fed. Rep. 486.

Harmon v. *Struthers*, 43 Fed. Rep. 443.

The function of Beach's cutting device is to *completely* sever at a single cut the *stay piece* from the continuous stay-strip so as to make it entirely free to be jammed on the box corner by the upper die. The stay piece must be *absolutely* freed, in Beach's side-feed machine, from the stay-strip, prior to contact with the movable die, for otherwise the engagement of the die with the strip would displace the stay-piece section from its position over the apex of the box corner.

On the other hand, the function of defendants' severing mechanism is to sever the strip gradually (from opposite edges inwardly) while it is being shaped to the upper die, the stay piece remaining connected to the stay-strip until the last moment of die approach, and also to hold the partially severed stay-strip from being drawn rearwardly when the carrying plate and pawl move rearwardly.

Therefore defendants' severing mechanism, in its relation to the co-operating dies, feeding and pasting mechanisms, is not only substantially different in construction, but is also substantially different in function. The function of Beach's shears is to completely sever, prior to the descending contact of the foot G' with the stay-piece section, and so to prevent the descending foot from displacing the stay-piece section in relation to its required position across the box corner. The function of defendants' severing mechanism, on the other hand, is to preserve the continuity of stay section and stay-strip until the movement of final compression and final engagement of the descending die upon a stay piece. Furthermore, the function of defendants' severing mechanism is to hold the free-end portion in fixed position over the box corner until the descending die has control of it. **Defendants' cutter is a part of the feeding mechanism**, inasmuch as it holds the partially severed stay-strip for rearward movement during the back motion of the carrying plate and pawl. These differences in function are important considerations in sup-

port of defendants' proposition that defendants' back-feed machine is a *radically* different kind of stay machine from complainant's side-feed machine.

The question is not whether complainant can construct a *side-feed machine* incorporating, in whole or in part, the Horton feed of which the V-cutter is an essential feature; but whether defendants' *back-feed machine*, in which the V-cutter forms an essential part of the feed mechanism, is within the scope of the claims in suit, in view of the fact that such a feeding mechanism cannot be put into the Beach patent machine, *back of* the in-turner I, *i* and down-turner H, so as to feed lengthwise of the apex of the box-corner — without a complete and unsuggested reconstruction of the Beach patent machine, if at all.

☞ Beach points out no way of reconstructing his machine into a *back-feed* machine.

Defendants' Horton Patent.

This patent (p. 305) was issued two months and fifteen days before Beach's original patent issued. It is entitled "Box Stay Machine," and states that "the invention has for its object to provide a simple, efficient and rapidly operating machine of this class." It shows (see Fig. 3) a reel; a strip thereon; a pasting mechanism an inseparably combined feed-and-cutting mechanism; and suitable dies, one of which is an essential part of the feeding mechanism. The functions of this feed are clearly stated in Horton's 4th claim (pp. 309-310) as follows:

> "4. In a box-staying machine, the combination with an angular mandrel, of a former, a shear-blade secured thereto, said former and shear-blade having lower, re-entrant acting faces, the table or guide *y* having a straight fixed shear-blade secured thereto, an upper-plate p^2, said plate and blade forming the walls of a strip-guiding slot, and the dog m' *secured* to said plate and designed to hold the strip during the rearward movement of the feeding device, said shear-blades also serving to hold such strip, substantially as set forth."

It is this new invention which the Court of Appeals for the First Circuit held to be a *known substitute* for Beach's wholly different feeding mechanism, which is absolutely structurally independent of his pressing mechanism and which is structurally identical with the old feeding mechanism of the Gates patent.

In point of fact Horton's patented mechanism is not a "substitute" at all for the old detached feed of the Beach patent. It can't be *substituted* for Beach's pair of feed rolls and intermediate elastic bed L; nor can Beach's independent feed mechanism be *substituted* for the Horton mechanism of claim 4, in the alleged infringing machines.

Nor is the Horton mechanism of his claim 4 a mechanical equivalent of Beach's independent feed mechanism, for it differs therefrom in (1) construction and (2) mode of operation,—unless indeed this Court sustain the dictum of the Second Circuit decisions holding that Beach's recited mechanisms are to be considered "without any restriction whatever to the details of mechanical construction"; and then hold further that the disclosures of the file-wrapper and contents are immaterial.

The only back feed box corner staying machines which feed a continuous strip of gummed or gummy paper or muslin are the prior patent to Horton and the later patent to Knowlton. The Knowlton patent machine and defendants' Horton patent machines are widely different, and it has never been suggested that defendants infringed the Knowlton patent. To hold that, because Horton's patent issued before Beach's, the Horton patent machine or patented features were *known substitutes* for Beach's side feed machine and elemental mechanisms was, it is submitted, a glaring error on the part of the Court of Appeals for the First Circuit, and was practically a begging of the real questions now submitted to this Court. The real question was and is whether defendants' elemental mechanisms as arranged in their machines are known substitutes or legal equivalents for Beach's elemental mechanisms as arranged in his patent machine and as set forth in the claims in suit *properly construed*; and it is wholly immaterial whether back feed machines (generically considered) were known at the date of Beach's patent on his side feed machine.

Non-Infringement Authorities.

Non-infringement as a matter of law, upon the facts of the case at bar, follows conclusively from the following decisions:

> *"That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other."*
>
> *Burr* v. *Duryee*, 1 Wall. 531, 579.

Rees v. *Gould*, 15 Wall 193-195; Held:

> "If the ingredient substituted [in defendants' machine] was [1] a new one, or [2] performs a substantially different function; or [3] was not known at the date of plaintiff's patent as a proper substitute for the one omitted from his patented combination," the defendant does not infringe.

Mr. Justice CLIFFORD cited —

> *Carver* v. *Hyde*, 16 Pet. 514;
> *Vance* v. *Campbell*, 1 Black. 427;
> *Roberts* v. *Harnden*, 2 Cliff. 504;
> *Mabie* v. *Haskell*, 2 Cliff. 511;
> *Brooks* v. *Fiske*, 15 How. 219;
> *Prouty* v. *Ruggles*, 16 Pet. 341;
> *Barrett* v. *Hall*, 1 Mass. 477;
> *Howe* v. *Abbott*, 2 Story, 194.

Fuller v. *Yentzer*, 94 U.S. 299-307; Held:

> "If the ingredient substituted was a new one, or performed a substantially different function, or was not known at the date of the patent in question as a proper substitute for the one omitted, in that event the defendant does not infringe. *Roberts* v. *Harnden*, 2 Cliff. 504."

Imhaeuser v. *Buerk*, 101 U.S. 647-664 (Mr. Justice CLIFFORD): Held:

> "Patentees of an invention, consisting merely of a combination of old ingredients, are entitled to equivalents; by which is meant that the patent, in respect to each of the respective ingredients comprising the invention, covers every other ingredient which, in the same arrangement of the parts, will perform the same function, IF it was well known as a proper substitute for the one described in the specificatien at the date of the patent."

In *Sargent* v. *Burgess*, 129 U.S. 25, 26, the court observed that:

> "Gorham evidently had no IDEA of such a construction as that of the Williams patent, found in defendant's washboard: and no person could, by following the description in the Gorham specification, arrive at defendant's structure."

> "The specific device described in and covered by the Wright patent could not be used in the appellants' combination, nor the appellants' 'spring in the appellees' combination.' This interchangeability, or non-interchangeability is an important test in determining the question of infringement."

Miller v. *Eagle Mfg. Co.*, 151 U.S. 208, citing—
Prouty v. *Ruggles*, 16 Pet. 336.
Brooks v. *Fiske*, 15 How. 212.
Eames v. *Godfrey*, 1 Wall. 78.

In perhaps the latest relevant case (*Miller* v. *Eagle Mfg. Co.*) the Supreme Court, by citing *Prouty* v. *Ruggles*, upholds the rule—

> "It is not the same combination if it substantially differs from it [the patented combination] in any of its parts."

In *Prouty* v. *Ruggles*, TANEY, C.J., states:

> "And this combination . . . is the thing patented. The use of any two of these parts . . . combined with a third which is

substantially different in form or manner of its arrangement and connection with the others is, therefore, not the thing patented. It is not the same combination if it substantially differs from it in any of its parts."

The well-known Morley case, 129 U.S. 263, upheld the doctrines of the foregoing cases, the closing paragraphs to the frequently imagined contrary notwithstanding.

It is therefore submitted that there should be a decree reversing the decision of the Court of Appeals for the First Circuit and awarding petitioners full costs in this Court, in the Court of Appeals and at the Circuit.

Respectfully submitted by

SAMUEL T. FISHER,
EDWARD S. BEACH,
Counsel for Petitioners.